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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,359	09/09/2003	Julio H. Soto	1087	2121

7590 12/13/2004  
Donald J. Ersler  
725 Garvens Avenue  
Brookfield, WI 53005

EXAMINER

LEGESSE, NINI F

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,359	<b>Applicant(s)</b> SOTO, JULIO H.	
	<b>Examiner</b> Nini F. Legesse	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 6, 15 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim1-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of the claims indicates that the claims are method claims. However, the content of the claims is strictly defining structure of a device not a method of using a device.

**For examination purpose, all claims are treated as product claims rather than method claims.**

### ***Typing Error***

Please change the expression "want" in claim 6 line 3, in claim 20 line 3, and in claim 15 line 3 to - - wand - -.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 7 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Quatkemeyer (US Patent No. 4,203,592) in view of Fairbanks (US Patent Application Publication No. US 2004/0178584).

Quatkemeyer discloses a device comprising: Tossing discs (30), a target disc (any one of disc 30 could be considered a target disc), a portable play surface (10), and tossing discs with different colors (see column 3 lines 1-5). However, Quatkemeyer fails to teach the use of a wall around a perimeter of the play surface and he fails to teach the use of sand. It is known that a lot of games are played at a beach. Fairbanks teaches the use of a wall around a perimeter of a play surface and the play surface if the game is played at the beach is inherently filled with sand. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Quatkemeyer device with a wall around the perimeter of the play surface as taught by Fairbanks so that discs/washers would not travel too far out from the playing area.

**Claims 2, 3 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Carovillano et al. (US Patent No. 6,015,151).

With regards to claims 2 and 3, the references as applied to claim 1 fail to include a disc retaining wire that is U-shaped. On the other hand, Carovillano teaches the use of such kind of disc retaining wire (see Figs. 1-2). And the retaining wire of Carovillano device is capable of being used as a measuring element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Quatkemeyer

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device with a disc retaining wire in order to easily transport and store the discs of the game.

With regards to claim 8, the references as applied to claim 1 fail to show different diameter and thickness for the discs. Carovillano shows different sizes of discs (12 and 14). Even though the references do not teach a smaller thickness for the tossing disc than the target disc, it would have been obvious in view of the routine optimization expected to make the discs any size, since such modification would have involved a mere change in the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art.

**Claims 4, 10, 13, 16, and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of F. Albach (US Patent No. 1,865,810).

The references as applied to claim 1 fail to include an elevated portable play surface. However Albach teaches the use of a playground equipment that is elevated from the ground (see Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to position the references as applied to claim 1 in an elevated position as taught by Albach so that children could have a lot of fun in a sand environment playing the tossing game. And at the same time the playground would help contain the children at one location.

**Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of McCaughan (US Patent No. 5,472,211).

The references as applied to claim 1 fail to include a disc retrieval wand. McCaughan teaches the use of a disc retrieval wand (14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Quatkemeyer device with a wand in order to easily retrieve the discs from the playing surface.

**Claims 10 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over A. J. Markey (US Patent No. 2,287,113) in view of Quatkemeyer.

Markey discloses a tossing disc (column 1 lines 5-7 indicate the use of a coin), a portable play surface wherein the pay surface is elevated above the ground (see Figs. 1-2) and a wall around the play surface perimeter (22). Markey fails to explicitly state the use of multiple discs. Quatkemeyer teaches the use of multiple discs in a target tossing game (see column 3, lines 32-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide multiple discs in the Markey's game device as taught by Quatkemeyer so that multiple players could play the game together.

**Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 10 above, and further in view of Carovillano et al.

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The references as applied to claim 10 fail to include a disc retaining wire that is U-shaped. On the other hand, Carovillano teaches the use of such kind of disc retaining wire (see Figs. 1-2). And the retaining wire of Carovillano device is capable of being used as a measuring element. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Markey device with a disc retaining wire in order to easily transport and store the discs of the game.

**Claims 14, 16, 18 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 10 above, and further in view of McCaughan.

The references as applied to claim 10 fail to include a disc retrieval wand. McCaughan teaches the use of a disc retrieval wand (14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Markey device with a wand in order to easily retrieve the discs from the playing surface.

***Allowable Subject Matter***

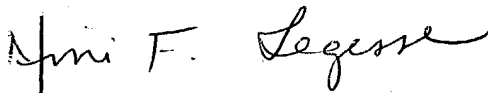
**Claims 6, 15, and 20** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (571) 272-4412. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571) 272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nini F. Legesse

12/08/04